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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

STOICA, ELLY GERALD

ART UNIT

PAPER NUMBER

1647

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,943	Applicant(s) KIM ET AL.	
	Examiner ELLY-GERALD STOICA	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-10 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 7-10 and 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the claims

1. In the amendment filed on 09/15/2008, Applicant cancelled claims 2, 5-6, amended claims 1, 7-10 and added the new claims 45-47. Claims 1, 7-10 and 45-47 are pending and currently examined.

Withdrawn claim rejections

2. The rejection of claims 1 and 7-10 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement or not being enabled is withdrawn in view of the amendments to the claims.

3. The rejection of claim 1 as indefinite is withdrawn in view of the amendments to the claim.

4. The rejection of the claims 1 and 8-10 under 35 U.S.C. 102(b) as being anticipated by Tang et al. is withdrawn in view of the amendments to the claims.

5. The rejection of the claim 1 under 35 U.S.C. 102(b) as being anticipated by the National Institutes of Health, Mammalian Gene Collection (MGC) entry: AGENCOURT_10614895 NIH_MGC_127 Homo sapiens cDNA clone IMAGE: 6745305 is withdrawn in view of the amendments to the claim.

6. The rejection of claims 8-10 under 35 U.S.C. 103(a) as being unpatentable over National Institutes of Health, Mammalian Gene Collection (MGC) entry: AGENCOURT_10614895 NIH_MGC_127 Homo sapiens cDNA clone IMAGE: 6745305 in view of Sibson et al. is withdrawn in view of the amendments to the claims.

New claim rejections necessitated by amendment

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 7-10 and 46-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the nucleic acid claimed in the claim 7 is a sequence that has the SEQ ID NO: 15 linked to the SEQ ID NO: 3 (human IL-32 alpha) or, since SEQ ID NO: 15 is actually an integral part of SEQ. ID. NO: 3, the desired claimed sequence is in fact SEQ ID NO: 3. As such, the metes and bounds of the claim could not be determined. Claims 8-10 are rejected as depending from claim 7.

With regard to the claims 46 and 47 it is unclear what is the provenience of the recited exons 3, 4, 7 and 8 since no SEQ ID NO is provided and no gene mentioned. Further, there is no relationship specified between the recited parts, such that the structure of the claimed nucleic acid is not clear. Thus, the metes and bounds of the claims 46 and 47 cannot be determined

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 8-10 (as they depend from claim 45) and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Tang et al. (WO/02/059260, 0801/2002- cited by Applicant). .

Tang et al. teach the Seq. Id. No.: 118 which contains a fragment between base pairs 121-657 which is identical with all the Seq. Id. No.: 6 claimed in the instant Application. Tang et al. also teach recombinant constructs comprising a nucleic acid having a fragment of Seq. Id. No.: 118 which again comprises all of the SEQ ID NO.: 6 of the instant Application. The recombinant construct may comprise a vector having the fragment inserted. the vector may further comprise regulatory sequences, including for example, a promoter, operably linked to the open reading frame "Operably linked" means that the isolated polynucleotide of the invention and an expression control sequence are situated within a vector or cell in such a way that the protein is expressed by a host cell which has been transformed (transfected) with the ligated polynucleotide/expression control sequence ((p.20, lines 11-33).

Therefore, Tang et al. anticipated all the limitations of the claims 45 and 8-10 (as they depend on claim 45).

Conclusion

11. Claims 7-10 and 45-47 are not allowed. Claim 1 is allowable since the SEQ ID NO.: 15 and 3 is free of prior art.

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12. Claim 8-10 are objected to for depending on rejected claims. If Applicant redraft s claims 8-10 so as they no longer depend from the rejected claim 45, they would be allowable.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELLY-GERALD STOICA whose telephone number is (571)272-9941. The examiner can normally be reached on 8:30-17:00 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath N. Rao can be reached on (571) 272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorraine Spector/

Primary Examiner, Art Unit 1647